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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/807,322 02/27/97 WILSKA K 297-005893-U

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LM02/0708

EXAMINER

MAUNG, N

ART UNIT

PAPER NUMBER

2744

DATE MAILED:

07/08/99

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/807,322

Applicant(s)

Wilska et al.

Examiner

Nay Maung

Group Art Unit

2744



☒ Responsive to communication(s) filed on Feb 5, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 4-32 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 29-32 is/are allowed.

☒ Claim(s) 1, 4, 5, 7-23, and 25-28 is/are rejected.

☒ Claim(s) 6 and 24 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 7-23, 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (WO 94/14274) in view of Virtuoso et al (Virtuoso).

Consider claims 1, 4, 8, 9, 15, 18, 19, and 28. Parulski discloses a device (fig. 2a), for data processing (p. 9, lines 10-27), which is a small-sized portable and hand-held work station comprising: a data processing unit (LUT 62); a display (fig. 1a, item 11); a user interface (i.e., keyboard; fig. 2a); at least one memory unit (p. 12, lines 20-26); a power source (inherent); and application software (p. 9, lines 10-15), the device also has a camera unit (fig. 2a, item 30), which includes a camera and optics (fig. 2a), and at least one memory unit (p. 9, lines 12) wherein at least a portion of the camera is located within the housing of the device (figure 2a, item 28). In addition, Parulski further discloses a portion of the camera unit is integrated in a circuit card (PCMCIA card) that is electrically coupled to the card slot of the device (fig. 2a).

Parulski does not disclose mean for transmitting image information processed by the data processing unit. However, the claimed limitation is very well-known in the telecommunication art as evidenced by Virtuoso. Virtuoso discloses a device for integration between voice and data radio communication having a computer for connecting a PCMCIA card which has a RF. section

for transmitting and receiving data and voice information to another location using a radio frequency channel.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Parulski's PCMCIA card to include a RF. section, as taught by Virtuoso, in order to transmit and receive data and voice information.

Consider claim 7. Parulski and Virtuoso fail to show the camera and the computer communicating by infrared links. However, it is well known in the art to communicate between two devices by radio, infrared and ultrasonic links. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the devices communicate by an infrared link in order to provide a wireless link.

Consider claim 10. A battery power source inherently present in Parulski's system in order to power the system.

Consider claims 11, 13 and 16. Parulski discloses a semiconductor camera (figure 2a; p. 9, lines 10-27).

Consider claim 12. Parulski discloses processing and storing the image in a memory unit for later recall (p. 12, lines 5-27).

Consider claims 14, 17, and 26. Parulski discloses a PCMCIA card (p. 9, lines 10-27).

Consider claim 20. Parulski discloses a means for performing character recognition of characters in an image recorded by the camera unit (p. 12, lines 5-27).

Consider claim 21. Parulski discloses a display means and a means for modifying an image appearing on the display (p. 12, lines 5-27).

Consider claim 28. The combination of Parulski and Virtuoso discloses all of the limitations as discloses above, but they fail to disclose transmitting a portion of the recorded image by facsimile transmission. However, it is well known in the art to send a file to another location by a facsimile transmission from a portable notebook computer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit a portion of an image recorded by the camera by a facsimile transmission in order to transfer the data to a person at a remote location.

Consider claims 22 and 23. See the rejection of claim 28 of this office action.

Consider claim 25. The combination do not specifically show the claimed limitation; however, it is well know in the art to have a portable notebook computer transmitting electronic mail messages, paging or connecting to an on-line information service. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a portable notebook computer capable of transmitting electronic mail messages, paging or connecting to an on-line information service to provide the user with access to different communication media with one device.

3. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski (WO 94/14274) in view of Virtuoso et al (Virtuoso) as applied to claim 19 above, and further in view of Simpson et al. (Simpson).

Consider claim 27. The combination of Parulski and Virtuoso fail to disclose using the Short Message Service. However, Simpson teaches that it is well know in the art to use the short

message service for advertising purposes in portable devices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a portable notebook transmit a SMS message including a portion of the image in order to provide a user of a portable device with a photograph of the advertised product.

4. Claims 1, 4-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paajanen et al (Paajanen) in view of Parulski (WO 94/14274).

Consider claims 1, 4, 5, 8, 9, 15, 18, 19, and 28. Paajanen discloses a portable personal computer and mobile telephone device integrated into one and the same body structure the body having: a display (3), a key board (2) for operating the computer and the mobile telephone (abstract), a data processing unit, a speaker, a microphone, at least one memory unit, a power source, an application software, and means for transmitting and receiving data and voice information (col. 3, lines 1-38) to another location using a radio frequency channel.

However, Paajanen do not explicitly show a PCMCIA card slot having a camera portion for taking picture and processing image information. However, the claimed limitation are very well-known in the art as evidenced by Parulski.

Parulski discloses a PCMCIA card having a camera portion of the camera unit is integrated in the circuit card (PCMCIA card) that is electrically coupled to a card slot of a computer for taking picture (fig. 2a) and for data processing (p. 9, lines 10-27), the computer which is a small-sized portable and hand-held work station comprising of a data processing unit (LUT 62); a display (fig. 1a, item 11); a user interface (i.e., keyboard; fig. 2a); at least one memory

unit (p. 12, lines 20-26); a power source (inherent); and application software (p. 9, lines 10-15), the computer also has a camera unit (fig. 2a, item 30), which includes a camera and optics (fig. 2a), and at least one memory unit (p. 9, lines 12) wherein at least a portion of the camera is located within the housing of the device (figure 2a, item 28).

Given that it is known in the art to include a PCMCIA card having a camera portion into a computer for taking picture, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Paajanen's mobile telephone/computer device in order to have a PCMCIA card with a camera; thus, a user can take a picture and transmit the picture to a base station in an emergency situation.

Consider claim 7. Paajanen and Parulski fail to show the camera and the computer communicating by infrared links. However, it is well known in the art to communicate between two devices by radio, infrared and ultrasonic links. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the devices communicate by an infrared link in order to provide a wireless link.

Consider claim 10. A battery power source inherently present in Paajanen's system in order to power the system.

Consider claims 11, 13 and 16. Parulski further discloses a semiconductor camera (figure 2a; p. 9, lines 10-27).

Consider claim 12. Parulski further discloses processing and storing the image in a memory unit for later recall (p. 12, lines 5-27).

Consider claims 14, 17, and 26. Parulski discloses a PCMCIA card (p. 9, lines 10-27).

Consider claim 20. Parulski further discloses a means for performing character recognition of characters in an image recorded by the camera unit (p. 12, lines 5-27).

Consider claim 21. Parulski further discloses a display means and a means for modifying an image appearing on the display (p. 12, lines 5-27).

Consider claim 28. The combination of Paajanen and Parulski discloses all of the limitations as discloses above, but they fail to disclose transmitting a portion of the recorded image by facsimile transmission. However, it is well known in the art to send a file to another location by a facsimile transmission from a portable notebook computer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit a portion of an image recorded by the camera by a facsimile transmission in order to transfer the data to a person at a remote location.

Consider claims 22 and 23. See the rejection of claim 28 of this office action.

Consider claim 25. The combination of Paajanen and Parulski do not specifically show the claimed limitation; however, it is well know in the art to have a portable notebook computer transmitting electronic mail messages, paging or connecting to an on-line information service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a portable notebook computer capable of transmitting electronic mail messages, paging or connecting to an on-line information service to provide the user with access to different communication media with one device.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paajanen et al. (Paajanen) in view of Parulski (WO 94/14274) as applied to claim 19 above, and further in view of Simpson et al. (Simpson).

Consider claim 27. The combination of Paajanen and Parulski fail to disclose using the Short Message Service. However, Simpson teaches that it is well know in the art to use the short message service for advertising purposes in portable devices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a portable notebook transmit a SMS message including a portion of the image in order to provide a user of a portable device with a photograph of the advertised product.

Allowable Subject Matter

6. Claims 29-32 are allowed over the prior art of record.
7. Claims 6 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 2/5/99 have been fully considered but they are not persuasive.
9. In the remarks, the applicant argued in substance:

(A) "...It is also argued that the camera unit disclosed by Parulski et al. is not actually integrated into a PCMCIA...

In contrast, a preferred embodiment of the camera unit disclosed in the instant patent application is incorporated into a PCMCIA card of standard dimensions, as is stated on page 6, lines 22 and 23 i.e., "...in which camera arrangement 140 and peripheral circuits required by it are integrated in..." (pp.9-11 of the applicants' argument).

In response to the argument, the limitations, as is stated on page 6, lines 22 and 23, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Therefore, the broadest claimed limitations are still read on the combination as disclosed above.

(B) "The examiner further admits, with regard to claim 7... The instant patent application certainly does suggest that the personal communications device may include an infrared link (see page 14, lines 12-18), but is disclosed as a means for transferring information between the personal communication device and, e.g. another computer, not necessarily the camera card." (p. 12 of the applicants' argument)

In response to the argument, the limitations, page 14, lines 12-18, but is disclosed as a means for transferring information between the personal communication device and another

computer, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Therefore, the broadest claimed limitations are still read on the combination as disclosed above.

(C) “with reference to claim 20, the Examiner states that Parulski... recognition of characters...whether an image is taken in color or monochrome, ... claim 20 of the instant patent application... for example, to convert images of... (see generally pages 8 and 9 of the instant patent application)...” (p. 12-13 of the applicants’ argument).

In response to the argument, the limitations, for example to convert images of, pages 8 and 9 of the instant, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

(D) “claim 27 refers to the use of SMS messages to transmit information from the personal communications device...

The Examiner argues that although the combination of Parulski and Virtuoso does not anticipate the use of SMS... The Examiner’s rejection appears to be an impermissible hindsight rejection... (pp. 14-15 of the applicants’ argument).

In response to the argument, Simpson in the same field of endeavor clearly teaches that it is well known in the art to use the short message service for advertising purposes in portable devices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a portable notebook transmit a SMS message including a portion of

the image in order to provide a user of a portable device with a photograph of the advertised product. It does not include knowledge gleaned only from the applicant's disclosure, but it is clearly teaching from the reference itself.

(E) "The Examiner also rejected claims 1, 4-26 and 28 under...

Paajanen et al. disclose a portable personal computer and a mobile telephone device...

It is argued that the Examiner's proposed combination of these two references does not directly lead to the device described and claimed...

It should also be noted that the OCR function described in the instant patent application can be located in the camera unit 14 itself...the functions disclosed are simply related to basic imaging, e.g. obtaining full resolution images and color correction... It should also be emphasized that the instant patent application discloses data gathering and processing functions... (pp. 16-17 of the application argument).

In response to the argument, the applicant remarks are in more detailed than the broadest claimed limitations; therefore, the broadest claimed limitation are still read on the combination as disclosed above.

In view of the preceding explanation, the examiner believes that claims are not in condition for allowance at this time.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

11. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

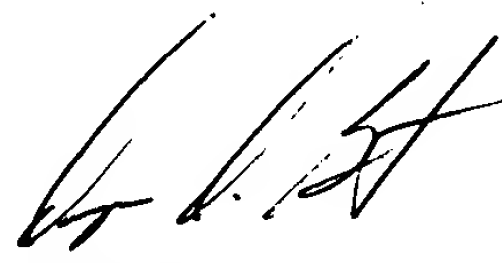
Serial Number: ~~08/444224~~ 08/807,322
Art Unit: 2608

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nay Maung whose telephone number is (703) 308-7745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

N. Maung 
July 1, 1999


DWAYNE D. BOST
SUPERVISORY PATENT EXAMINER
GROUP 2700